

REMARKS

This second supplemental amendment is submitted in response to the Notice of Non-Compliant Amendment dated June 7, 2004. Applicant believes that, because the present application is a reissue application, the Notice of Non-Compliant Amendment was issued in error, and therefore the claim amendments submitted above are identical to those presented in Applicant's previous response.

More specifically, the Notice of Non-Compliant Amendment asserts that Applicant's previous response is deficient for failing to provide a complete listing of all claims, for failing to provide each claim with a proper status identifier, for failing to begin each section of the amendment on a separate page, and for using single brackets to indicate text to be deleted from the claims. While the foregoing deficiencies are applicable to amendments submitted in "regular" applications, the present application is a reissue application, and therefore the guidelines for making amendments are provided in 37 C.F.R. § 1.173.

In particular, 37 C.F.R. § 1.173(b)(2) requires that the amendment paper "include the entire text of each claim being changed and of each claim being added by such amendment paper." Accordingly, there is no requirement to provide a complete listing of all of the claims, as requested in the Notice of Non-Compliant Amendment. Similarly, 37 C.F.R. § 1.173(b)(2) further states that, "For any claim changed by the amendment paper, a parenthetical expression...should follow the claim number." Applicant has identified the status of each claim amended or added by the present amendment paper, and therefore has complied with the provisions of this section.

In addition, 37 C.F.R. § 1.173(d) sets forth the manner in which changes to the specification and claims are to be made. Specifically, it states, "The matter to be omitted must be enclosed in brackets." This is in contrast to 37 C.F.R. § 1.121(c)(2), which states that "double-brackets" may be used to identify matter to be omitted by amendment papers submitted in "regular" applications. Accordingly, the single brackets used in the present (and previous) amendment meets the requirements for amendment papers filed in reissue applications.

Finally, the Notice of Non-Compliant Amendment indicates that each section of the amendment must begin on a separate page. Counsel for Applicant is unable to identify the

authority for this requirement, but, in the interest of advancing the prosecution of this matter, has reformatted this response so that each section now begins on a separate page.

In view of the foregoing, Applicant believes that the present amendment paper compliance with all requirements of amendment papers submitted in reissue applications, and therefore requests that the following comments regarding substantive issues be considered.

Turning to the Office action of April 21, 2004, Applicant hereby submits this response to properly identify amendments to the claims. More specifically, the previous amendment made changes to the claims that failed to comply with 37 CFR 1.173(b). This supplemental amendment shows changes to the claims relative to the claims that were in effect as of the date of filing of the reissue application. In particular, the changes to claims 1, 4, 17, 19, and 20 are now shown as relative to the claims that issued in the original patent. The following remarks represent Applicant's response to the office action of September 25, 2002.

The present application was originally filed with claims 1-28. Applicant notes with appreciation the Examiner's indication that claims 4-7 and 9-16 are allowable. With this amendment, claims 1, 4, 17, 19, and 20 have been amended and claims 9, 13, and 22 have been canceled, leaving claims 1-8, 10-12, 14-21, and 23-28 pending in the application. Amended independent claims 1 and 17 more closely conform to allowed claims 4 and 7, and therefore more clearly define over the cited prior art. In view of the amendments and remarks presented herein, reconsideration and allowance of all pending claims are respectfully requested.

Turning to the Office action of September 25, 2002, the Examiner asserts a restriction requirement against the application, stating that claims 21-28 are directed to an invention that is independent or distinct from the originally claimed invention. In particular, the office action states that "the combination as claimed does not require the particulars of the subcombination as claimed because [a] layer of filter paper is not required to have a thickness to remove and trap lipids." The office action further states that the subcombination has separate utility, such as "with a coffee maker not requiring a spout for delivery." The office action further alleges that applicant has received an action on the merits for the originally presented invention, and therefore applicant has constructively elected claims 1-20 for prosecution on the merits, thereby withdrawing claims 21-28 from consideration.

Applicant traverses the restriction requirement in view of the claims as amended herein. Independent claims 1 and 17 have been amended to recite "a filter thickness sufficient to effectively remove and trap lipids" from the coffee. Independent claims 4 and 7 already include similar recitations. Accordingly, the filter thickness element cited by the office action as lacking in the combination claims is now present in claims 1-20, and therefore the restriction requirement should be withdrawn and all pending claims (i.e., claims 1-8, 10-12, 14-21, and 23-28) should be considered.

Should the Examiner persist in the restriction requirement, applicant notes that the effect of such a position in the official action is that the Patent Office admits that the Group I claims are patentable over a disclosure of the combination of Group II, and *vice versa*. M.P.E.P. § 802.01 states that **the distinctness required for restriction means that the subjects, including "combination and part (subcombination) thereof ... ARE PATENTABLE (novel and unobvious) OVER EACH OTHER"** (emphasis with capital letters in original). (See also M.P.E.P. § 808.02, which states that where "related inventions are not patentably distinct as claimed, restriction ... is never proper.") Thus, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed method and devices of the Group I claims are patentable over any disclosure of a filter for use in an espresso-type coffee maker according to the Group II claims. See, e.g., M.P.E.P. § 802.01. Likewise, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed filter of the Group II claims is patentable over any disclosure of the filter devices and methods, according to the Group I claims. *Id.* Each of independent claims 1, 4, 7, 17, and 21 includes similar elements, and therefore such admissions would appear to be improper.

In view of the foregoing, withdrawal of the restriction requirement and consideration of claims 21 and 23-28 with claims 1-8, 10-12, and 14-20 are respectfully requested. To satisfy 37 C.F.R. 1.143, the applicant hereby provisionally elects, with traverse, the claims of Group I, i.e., claims 1-8, 10-12, and 14-20. In doing so, the applicant does not intend to abandon the scope of the non-elected claims as originally filed, but may pursue the non-elected claims, either by petition for further review or in a divisional application, if the restriction requirement is not withdrawn upon reconsideration.

With regard to the Office action comments regarding 37 CFR 1.178, applicant has previously forwarded original U.S. Patent No. 6,016,740 with the Amendment dated January 24, 2003.

The office action rejects claims 1-20 based on a defective reissue declaration. More specifically, the office action notes that the reissue declaration fails to state that the applicant is the sole owner. A Supplemental Reissue Declaration was submitted with Applicant's previous response dated January 24, 2003, which includes the appropriate statement at paragraph 2. Withdrawal of this ground of rejection is respectfully requested.

Claim 9 stands rejected under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 251 for including new matter. Claim 9 has been canceled, and therefore this ground of rejection should be withdrawn. Applicant notes that claims 13 and 22, which were identical to claim 9 but were not rejected, have also been canceled.

Enclosed with Applicant's response dated January 24, 2003, was an Information Disclosure Statement including all of the references cited in the original patent (U.S. Patent No. 6,016,740), as requested in the office action.

Turning to the rejections on the art, claims 1, 8, 17, and 18 have been rejected under 35 U.S.C. § 102(b) as anticipated by Shigenobu et al. (U.S. Patent Application No. 4,506,596). Applicant traverses this rejection.

Claim 17 has been amended to add the last sub-paragraph noted above, which reads, "wherein the at least one layer of filter paper has a filter thickness sufficient to effectively remove and trap lipids from the coffee beans. As such, independent claims 1 and 17, as amended herein, each specify a filtering device and method that includes a filter having "a filter thickness sufficient to effectively remove and trap lipids" from the coffee. It is not seen that Shigenobu et al. disclose or suggest such

Instead, Shigenobu et al. disclose a beverage brewing apparatus for use in an automatic coffee vending machine. The apparatus includes a brewing cylinder 67 positioned above a "stage" 13, which defines a brewing hole 17, as best shown in FIG. 2. A wire net 20 extends across a top opening 18 of the stage 13. A filter tape 30 extends over the stage 13 and the wire net 20, and is formed of paper, cotton, rayon, or other suitable filter material. A pressurizing piston 80 is slidably fitted in the brewing cylinder 67. In operation, coffee powder is fed into the brewing cylinder 67, and the piston 80 is actuated to pressurize the

cylinder 67. Hot water is then fed into the brewing cylinder 67. As the hot water passes through the coffee powder, a coffee solution is percolated. The coffee solution passes through the filter tape 30 and wire net 20 to discharge through the brewing hole 17. Shigenobu et al. fail to disclose or suggest a desired thickness for the filter tape 30, let alone a thickness sufficient to remove and trap lipids, as specified in claims 1 and 17.

Because Shigenobu et al. do not disclose or suggest each of the elements recited by the claims at issue, it follows that the claims are not anticipated thereby. In addition, Shigenobu et al. fail to disclose or suggest that it would be desirable or even possible to provide a filter thickness sufficient to remove and trap lipids, and hence a prima facie case of obviousness has not been established. See In re Sernaker, 217 U.S.P.Q. 1 (Fed. Cir. 1983) and Ex Parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985).

Claims 2-3 and 8 depend from claim 1 and claims 19-20 depend from claim 17, and therefore these claims are similarly patentable over Shigenobu et al. for the reasons presented above.

The office action further rejects claims 2-3 and 19-20 under 35 U.S.C. § 103(a) as obvious over Shigenobu et al. in view of Krebs (U.S. Patent No. 4,052,318). Krebs is relied on solely for teaching a filter having multiple layers. Krebs does not disclose or suggest the removal and trapping of lipids from coffee. Accordingly, for the same reasons presented above with respect to the rejection of claims 1 and 17, the rejection of claims 2-3 and 19-20 should be withdrawn.

Applicant notes that claim 21, and claims 23-28 dependent directly or indirectly thereon, specify a filter having a layer of paper filter material with a thickness to effectively remove and trap lipids and fine grounds from the brewed coffee and to reduce the trapped lipids in the brewed coffee. Accordingly, claims 21 and 23-28 are allowable over the cited prior art for the same reasons presented above with respect to claims 1 and 17.

Applicant notes that the amendment to claim 4, which has been allowed, simply corrects an obvious error that does not affect the scope of the claim. Entry of this amendment and continued allowance of claim 4 are respectfully requested.

Claim 19 is amended to add "at least one layer of" before the word "filter" in line 1 of the claim and to add "of filter paper" at the end of the claim. Claim 20 is amended to add "plurality of layers of" before the word "filter" in line 1 of the originally presented claim and

Appl. No. 10/047,852
Resp. dated June 15, 2004
Reply to Office Action of June 7, 2004

to remove the word "layers" after the word "paper" in line 2 of the originally presented claim. These changes are editorial in nature and sufficiently supported by the original specification.

In view of the foregoing amendments and remarks, it is submitted that claims 1-8, 10-12, 14-21, and 23-28 as now appearing in this application are in good and proper form for allowance. A favorable action on the part of the examiner is respectfully solicited.

If, in the opinion of the examiner a telephone conference would expedite prosecution of the subject application, the examiner is invited to call the undersigned attorney.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

Dated: June 15, 2004

By:



Brent E. Matthias
Reg. No. 41,974
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-6300